

**REMARKS/ARGUMENT**

Reconsideration of this application is respectfully requested.

The Examiner has rejected claim 1.

Claims 2-40 have been added.

Claim 1 has been amended. It is respectfully submitted that no new matter has been added.

***CLAIM REJECTIONS – 35 USC §103***

The Examiner has rejected claim 1 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,345,461 of Barton, et al. (hereafter "Barton") in view of U.S. Patent No. 5,887,032 of Cioffi (hereafter "Cioffi").

In regard to the rejection of claim 1 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Barton teaches a method comprising:... using said models and said cross-talk functions to diagnose probable causes of events detected in said communications system (col. 1, l. 60 - col. 2, line 7; col. 25, lines 50-67)....

(5/21/03 Office Action, p. 3).

Applicants submit that claim 1 is not obvious in view of Barton and Cioffi. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine Barton and Cioffi.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of May 21, 2003, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex

scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claim 1, even if Barton and Cioffi were combined, such a combination would lack one or more features of claim 1. Amended claim 1 recites the feature of using said statistical models and said a priori distributions to diagnose probable causes of events detected.... (emphasis added)

Barton does not disclose this feature as disclosed in applicants' claim 1. As, the Examiner states in his Office Action "Barton does not specifically teach of creating a priori distributions of cross-talk transfer functions." (5/21/03 office Action, p.3) Since, Barton does not teach creating a prior distributions, Barton can not disclose using said statistical models and said a priori distributions, as claimed by applicants in Claim 1. Nowhere does Barton describe this feature.

Nor does Cioffi disclose "using said statistical models and said a priori distributions...." as claimed by applicants. Cioffi describes method and apparatus for crosstalk cancellation. (Cioffi, title) More specifically, Cioffi describes modeling cross-talk interference, subtracting the estimated cross-talk from a corrupted received signal to mitigate the effects of cross-talk. (Cioffi, col. 11, ll. 30-61) The resulting compensated received signal is generated from the estimated cross-talk. Nowhere does Cioffi teach "using said statistical models and said a priori distributions to diagnose..." Thus, because neither, Barton nor Cioffi disclose applicant's claim 1, applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. §103(a) by Barton in view of Cioffi.

For the foregoing reasons, applicant respectfully submits that the applicable objections and rejections have been overcome and that the claims are in condition for allowance.

If there are any additional charges, please charge Deposit Account No. 02-2666.

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Respectfully submitted,

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